

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BRETT GUNNINK, JAYANTH KANUNAR and ZHUOXIONG LIANG

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Appeal No. 1998-1217  
Application No. 08/405,599

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ON BRIEF

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Before GARRIS, PAK, and JEFFREY T. SMITH, Administrative  
Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1-23 which are all of the claims remaining in the application.

The subject matter on appeal relates to a process for making compacts from coal particles and to a coal compact comprising compacted coal particles. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

Appeal No. 1998-1217  
Application No. 08/405,599

1. A process for making compacts from coal particles, the process comprising:

heating a particulate feed comprising substantially water-saturated coal particles to a temperature greater than about 100° C, said particulate feed being heated at a pressure sufficient to prevent water in said feed from boiling;

compacting said heated particulate feed in a mold by applying a compressive stress to said heated feed to form said compact; and

cooling the formed compact, said compact being cooled at a pressure sufficient to prevent water in said cooling compact from boiling.

The references relied upon by the Examiner as evidence of obviousness are:

Beckmann 1974	3,841,849	Oct. 15,
Dick, Jr. 17, 1980	4,208,188	June
Phillips 1915	1,149,536	Aug. 10,
Beaudequin '570 1926	1,597,570	Aug. 24,
Beaudequin '571 1926	1,597,571	Aug. 24,

Claims 1-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dick in view of Phillips and Beaudequin'570 and

Appeal No. 1998-1217  
Application No. 08/405,599

Beaudequin'571.

Claims 21-23 stand rejected under 35 U.S.C. § 103 as being  
unpatentable over Dick in view of Beckmann.

Appeal No. 1998-1217  
Application No. 08/405,599

OPINION

For the reasons which follow, we will sustain the § 103 rejection of claims 21-23 but not the § 103 rejection of claims 1-20.

Each of the appealed process claims 1-20 requires heating substantially water-saturated coal particles to a temperature greater than about 100°C under a pressure sufficient to prevent water in the feed from boiling. As correctly pointed out by the Appellants in their briefs, the references applied by the Examiner in her rejection of these claims contain no teaching or suggestion concerning this claim requirement. More specifically, Dick contains no disclosure regarding any type of heating step. While the Phillips and Beaudequin references disclose processes which include a step of heating to temperatures above the boiling point of water, these references contain no teaching or suggestion of heating coal particles to these temperatures under a pressure sufficient to prevent water in the coal feed from boiling as here claimed.

In light of the foregoing, we cannot sustain the Examiner's § 103 rejection of claims 1-20 as being unpatentable over Dick in view of Phillip and Beaudequin'570 and Beaudequin'571.

Appeal No. 1998-1217  
Application No. 08/405,599

An entirely different circumstance is presented by the Examiner's § 103 rejection of appealed product claims 21-23 as being unpatentable over Dick in view of Beckmann.<sup>1</sup> This is because the coal compact defined by the here rejected claims, in our view, is indistinguishable from the consolidated coal slug of Dick. We are mindful of the Appellants' point that Dick contains no disclosure of the tensile/compressive strength characteristics recited in the appealed product claims. Nevertheless, patentee's, slugs and Appellants' compacts are both formed by subjecting the same type of particulate feed to the same type of compressive stress (cf., appealed process claims 1 and 3 with lines 10-45 in column 3 of Dick). While Dick's process does not include the type of heating step defined, for example, by appealed process claim 1 as noted by Appellants, it is significant that the product claims on appeal contain no recitation of such a heating step and, perhaps more importantly, that appealed process claim 1 would encompass a

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<sup>1</sup> The Examiner has relied upon Beckmann for reasons not relevant to the claims or issues under consideration. Accordingly, we will not discuss this reference in our assessment of the rejection of the appealed product claims before us.

Appeal No. 1998-1217  
Application No. 08/405,599

heating step of mere seconds in duration which would cause little if any discernable difference in the ultimate product resulting from this process.

Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the Patent and Trademark Office can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on "inherency" under 35 U.S.C. § 102, on "prima facie obviousness" under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art products. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977).

In summary, the product defined by appealed claim 21 is indistinguishable from the product of Dick on the record before us. In particular, the Appellants have not carried their burden of showing that Dick's products do not necessarily or inherently possess the tensile/compressive strength characteristics of

Appeal No. 1998-1217  
Application No. 08/405,599

their claimed product. Under these circumstances, we will sustain the Examiner's 35 U.S.C. § 103 rejection of claims 21-23 as being unpatentable over Dick in view of Beckmann.<sup>2</sup>

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<sup>2</sup> It is appropriate to emphasize that the Appellants have grouped claims 21-23 together on this appeal; see page 14 of the brief.

Appeal No. 1998-1217  
Application No. 08/405,599

The decision of the Examiner is affirmed-in-part.

AFFIRMED-IN-PART

BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHUNG K. PAK	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY T. SMITH	)	
Administrative Patent Judge	)	



Appeal No. 1998-1217  
Application No. 08/405,599

SENNIGER POWERS LEAVITT AND ROEDEL  
ONE METROPOLITAN SQUARE  
16TH FLOOR  
ST LOUIS, MO 63102